

REMARKS

This Response is submitted in reply to the Office Action dated May 14, 2009, and in accordance with the telephone interview on July 23, 2009. Claims 1, 2, 4, 9, 10, 11, 18, 19, 21, 26 to 30, 36 to 38, 40, 45, 46, 48, 49, 56 to 58, 60 to 62 and 65 to 67 are each amended. Claims 5, 13, 22, 32, 41, and 52 stand canceled. No new matter has been added by these amendments. Please charge deposit account number 02-1818 for any fees associated with this Response.

The Office Action rejected Claims 1 to 4, 6 to 12, 14 to 21, 23 to 31, 33 to 40, 42 to 51, and 53 to 67 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application No. 2003/0036419 to Baerlocher et al. ("Baerlocher") in view of one having ordinary skill. Applicant disagrees with and traverses this rejection for at least the following reasons. Additionally, certain of the claims have been amended for clarity.

The Abstract of Baerlocher discloses that:

[t]he present invention provides a processor controlled gaming device that randomly generates a plurality of positions or digits of an award and enables the player to pick which position or digit receives a first randomly generated number, which digit receives a second randomly generated number, etc., until each of the positions have a number, whereby the gaming device determines the player's ultimate award. The present invention further provides a plurality of modification methods for modifying the digits of the award.

Amended independent Claim 1 is directed to a gaming device including, amongst other elements, at least one memory device which stores a plurality of instructions, which when executed by the at least one processor, cause the at least one processor to operate with the at least one display device, the at least one input device, and the mechanical wheel, for a play of a game, to: (a) display a plurality of offer components, wherein each of the offer components has an activated and a deactivated state, (b) select at least one offer component to activate from the plurality of displayed offer components, (c) thereafter, display at least one of a plurality of award values of at least one of a plurality of awards associated with at least one of the activated offer components, wherein each of the plurality of awards is statically associated with one of the offer components for the play of the game, each of the plurality of awards has an

award value greater than zero, and a plurality of the award values have a same number of digits, (d) determine an offer based on a mathematical summation of the award values of all of the awards associated with the activated offer components, wherein the determined offer includes a plurality of activated offer components associated with the awards having award values with the same number of digits, (e) display the determined offer, (f) enable a player to accept or reject the determined offer, (g) provide the determined offer to the player if the player accepts the determined offer, and (h) if the player rejects the determined offer: (1) cause the mechanical wheel to generate and display a selection of at least one of the sections of the mechanical wheel, wherein each section of the mechanical wheel is associated with one of a plurality of different displayed component number modifiers, and each component number modifier has a displayed value, (2) change the state of at least one of the plurality of offer components, wherein the number of offer components changing state is based on the value associated with the component number modifier of the selected section of the mechanical wheel, (3) determine a subsequent offer based on a mathematical summation of the award values of all of the awards associated with the currently activated offer components, wherein the award values of all of the awards associated with the currently activated offer components are each independent of the value associated with the component number modifier of the selected section of the mechanical wheel, and (4) display the determined subsequent offer to the player.

As discussed during the interview, under a first interpretation of Baerlocher, each digit position of an offer represents an award value having a different number of digits than an award value of another digit position. Applicant submits that under this first interpretation of Baerlocher, Baerlocher does not anticipate or render obvious determining an offer wherein the determined offer includes a plurality of activated offer components associated with the awards having award values with the same number of digits. For example, under this first interpretation of Baerlocher, if a 1 is determined for the hundred's digit position, such that the hundred digit position is associated with an award value of 100, a 5 is determined for the ten's digit position, such that the ten's digit position is associated with an award value of 50, and a 6 is determined for the one's

digit position, such that the one's digit position is associated with an award value of 6, than a determined offer resulting from a summation of each of these award values has a value of 156 (i.e., $100+50+6=156$). In this example, no award values of the determined offer have a same number of digits. That is, under this interpretation of Baerlocher, 100 is an award value having three digits, 50 is an award value having two digits, and 6 is an award value having one digit, and thus each award value has a different number of digits. On the other hand, the gaming device of amended independent Claim 1 includes, amongst other elements, at least one memory device which stores a plurality of instructions, which when executed by at least one processor, cause the at least one processor to operate to determine an offer based on a mathematical summation of the award values of all of the awards associated with the activated offer components, wherein the determined offer includes a plurality of activated offer components associated with the awards having award values with the same number of digits.

During the interview, the Examiner acknowledged that under this first interpretation, Baerlocher does not anticipate determining an offer which includes a plurality of activated offer components associated with the awards having award values with the same number of digits. However, the Examiner asserted that, under this first interpretation, it would have been obvious to one of ordinary skill at the time of the invention to have modified Baerlocher to determine an offer which includes a plurality of activated offer components associated with the awards having award values with the same number of digits. Applicant respectfully disagrees and submits that such a statement is conclusory and unsupported by any evidence or rationale. According to the MPEP, the mere statement that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. MPEP 2143.01 (IV). No such articulated reasoning with rational underpinning has been provided to support the Examiner's conclusion. As such, no *prima facie* case of obviousness has been established and thus the Examiner's assertion is improper.

Moreover, the Examiner is ignoring the express warnings by the Supreme Court in KSR International Company v. Teleflex Inc., et al., (550 U.S. 398, 2007) that a "factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning." The Examiner is improperly working backwards from the claimed invention to piece together elements from Baerlocher and elements of the present application to form the claimed invention. Obviousness cannot be based on the hindsight combination of components selectively culled from prior art to fit the parameters of the claimed invention. The Examiner's picking and choosing among individual parts of the prior art reference and the present application as a mosaic to recreate a facsimile of the claimed invention is clearly improper.

In this case, it would not have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming device of Baerlocher to result in the gaming device of amended independent Claim 1 without reasonably being construed as improper hindsight reconstruction. Only with the benefit of hindsight reasoning is the Examiner picking and choosing different elements from Baerlocher as well as different elements from the present application to recreate the claimed invention to form the basis of these conclusions. Accordingly, Applicant submits that such reasoning is improper.

Additionally, as discussed during the interview, under a second interpretation of Baerlocher, each digit position represents a single digit number which is randomly determined for that digit position and the offer is determined based on the displayed arrangement of the single digit numbers. Applicant submits that under this second interpretation of Baerlocher, Baerlocher does not anticipate or render obvious determining an offer based on a mathematical summation of the award values of all of the awards. For example, if a 1 is determined for the hundred's digit position, a 5 is determined for the ten's digit position and a 6 is determined for the one's digit position and the 1, 5 and 6 each represent a single digit number, then an offer of 156 (i.e., one-hundred-fifty-six) is not determined based on a mathematical summation of the award values of all of the awards. That is, under this interpretation of Baerlocher, a

mathematical summation of 1, 5 and 6 does not result in an offer of 156. Rather, a mathematical summation of 1, 5 and 6 results in a offer of 12 (i.e., $1+5+6=12$). On the other hand, the gaming device of amended independent Claim 1 includes, amongst other elements, at least one memory device which stores a plurality of instructions, which when executed by at least one processor, cause the at least one processor to operate to determine an offer based on a mathematical summation of the award values of all of the awards.

During the interview, the Examiner acknowledged that under this second interpretation of Baerlocher, Baerlocher does not anticipate determining an offer based on a mathematical summation of the award values of all of the awards. However, the Examiner asserted that, under this second interpretation, it would have been obvious to one of ordinary skill at the time of the invention to have modified Baerlocher to determine an offer based on a mathematical summation of the award values of all of the awards. Applicant respectfully disagrees and submits that such a statement is conclusory and unsupported by any evidence or rationale. According to the MPEP, the mere statement that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. MPEP 2143.01 (IV). No such articulated reasoning with rational underpinning has been provided to support the Examiner's conclusion. As such, no *prima facie* case of obviousness has been established and thus the Examiner's assertion is improper.

Moreover, the Examiner is ignoring the express warnings by the Supreme Court in KSR International Company v. Teleflex Inc., et al., (550 U.S. 398, 2007) that a "factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning." The Examiner is improperly working backwards from the claimed invention to piece together elements from Baerlocher and elements of the present application to form the claimed invention. Obviousness cannot be based on the hindsight combination of components selectively culled from prior art to fit the parameters of the claimed invention. The Examiner's

picking and choosing among individual parts of the prior art reference and the present application as a mosaic to recreate a facsimile of the claimed invention is clearly improper.

In this case, it would not have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming device of Baerlocher to result in the gaming device of amended independent Claim 1 without reasonably being construed as improper hindsight reconstruction. Only with the benefit of hindsight reasoning is the Examiner picking and choosing different elements from Baerlocher as well as different elements from the present application to recreate the claimed invention to form the basis of these conclusions. Accordingly, Applicant submits that such reasoning is improper.

During the interview, the Examiner further stated that a broad interpretation of the term "summation" includes, for example, combining or arranging the 1, 5 and 6 to form an offer of 156. Applicant respectfully disagrees. Nevertheless, to advance prosecution, Applicant has amended certain of the claims to clarify that an offer is based on a mathematical summation of the award values of all of the awards. As discussed above, unlike the gaming device of amended independent Claim 1, Applicant submits that under the second interpretation, Baerlocher does not anticipate or render obvious determining an offer based on a mathematical summation of the award values of all of the awards.

Moreover, Applicant reiterates the argument conveyed in the Responses to the Office Actions of June 3, 2008, October 23, 2008 and April 24, 2009, that Baerlocher does not anticipate or render obvious a plurality of different displayed component number modifiers, wherein each component number modifier has a displayed value. That is, the possible award modifications of Baerlocher are not displayed to the player when the player decides whether to keep the currently generated award or risk the award to generate one of the award modification methods.

For at least these reasons, amended independent Claim 1 is patentably distinguished over Baerlocher and is in condition for allowance.

Claims 2 to 4 and 6 to 9 depend directly or indirectly from amended Claim 1 and are allowable for similar reasons, and because of the additional features recited in these claims.

Amended independent Claims 10, 18, 29, 37, 48, 56, 57, 58, 62, 66, and 67 each include certain similar elements to amended independent Claim 1. For reasons similar to those discussed above with respect to amended independent Claim 1, amended independent Claims 10, 18, 29, 37, 48, 56, 57, 58, 62, 66, and 67 (and dependent Claims 11, 12, 14 to 17, 19 to 21, 23 to 28, 30, 31, 33 to 36, 38 to 40, 42 to 47, 49 to 51, 53 to 55, 59 to 61, and 63 to 65) are each patentably distinguished over Baerlocher and are in condition for allowance.

As previously stated in the Response to Office Action dated April 24, 2009, Applicant submits that on June 3, 2008, Applicant's representative and the Examiner had an interview. On June 16, 2008, the Examiner issued an Interview Summary which stated:

[t]he applicant and the Examiner both agree that the prior art teaches the game play methodology.

In a Response to Final Office Action dated June 25, 2008, Applicant stated:

[a]pplicant respectfully disagrees and submits that no agreement was reached regarding the game play methodology of the prior art in relation to the claims of the present application.

In a July 30, 2008 Office Action, the Response to Arguments Section on Page 5 stated:

[o]ne final note for the record, during the interview on 6/3/08 with Mr. Abern, Mr. Abern acknowledged the prior art teaching the gameplay methodology of the applicant's limitations when asking the Examiner to identify any allowable subject matter. Therefore it is possible for the applicant to disagree with this statement since these current arguments are made by Mr. Masia.

Following receipt of this July 30, 2008 Office Action, Applicant's representative contacted the Examiner to disagree that the prior art teaches the game play methodology.

On August 13, 2008, the Examiner issued a Supplemental Interview Summary which stated:

[t]he Examiner returned Mr. Masia's phone call to clarify a section of the last Action's Response to Arguments: 'One final note for the record, during the interview on 6/3/08 with Mr. Abern, Mr. Abern acknowledged the prior art teaches [teaching] the gameplay methodology of the applicant's limitation when asking the Examiner to identify any allowable subject matter.' For the record, the Examiner's use of the term gameplay methodology refers to the game's overall idea or theme: a player is allowed to accept or reject an award offer knowing a rejection will result in a with mathematical alteration of the offer.

Accordingly, Applicant submits that this issue had been resolved.

However, Page 5 of the preset Office Action stated:

[o]ne final note for the record, during the interview on 6/3/08 with Mr. Abern, Mr. Abern acknowledged the prior art teaching the gameplay methodology of the applicant's limitations when asking the Examiner to identify any allowable subject matter. Therefore it is possible for the applicant to disagree with this statement since these current arguments are made by Mr. Masia.

As seen above, this exact passage was also included in the previous Office Actions dated July 30, 2008, and February 4, 2009. Again, Applicant respectfully disagrees and submits that no agreement was reached regarding the game play methodology of the prior art in relation to the claims of the present application.

An earnest endeavor has been made to place this application in condition for formal allowance, which is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

K&L Gates LLP

BY 

Adam H. Masia
Reg. No. 35,602
Customer No. 29159

Dated: August 13, 2009